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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|-----------------------|--------------------------------|------------------------|
| 10/650,541 | 08/28/2003 | Daniel C. Birkestrand | ROC920030176US1 | 9041 |
| 46797 7590 09/24/2007 IBM CORPORATION, INTELLECTUAL PROPERTY LAW DEPT 917, BLDG. 006-1 3605 HIGHWAY 52 NORTH ROCHESTER, MN 55901-7829 | | | EXAMINER LANIER, BENJAMIN E | |
| | | | ART UNIT 2132 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,541

Applicant(s)

BIRKESTRAND ET AL.

Examiner

Benjamin E. Lanier

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 28-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 23 July 2007 amends claims 28-36. Claims 1-27 have been cancelled. Claims 44-51 have been added. Applicant's amendment has been fully considered and entered.

Election/Restrictions

2. Applicant's election without traverse of Group IV in the reply filed on 23 July 2007 is acknowledged.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 28-51 are rejected under 35 U.S.C. 102(a) and/or 102(e) as being anticipated by Lewis, U.S. Publication No. 2003/0040962. Referring to claims 28, 44, Lewis discloses a system for on-demand rental and purchase of digital data products wherein users who have purchased digital data content are provided with unlimited usage of said content upon delivery to the data management system of the user ([0087] & [0098] & [0222]), which meets the limitation of recording a compliant state of the computerized apparatus, with respect to the on-demand resource, in which a system function uses the on-demand resource with authorization. If the user

has not purchased the content, they may be granted a preview or demo time period to access the content on their data management system ([0205]), which meets the limitation of determining an in-compliant state, with respect to the on-demand resource, in which the system function uses the on-demand resource without authorization, and initiating a grace period during which the system function may continue to use the on-demand resource while in the in-compliant state.

Referring to claims 29, 45, Lewis discloses that the user data management system includes storage partitions for storage of the content ([0094] & [0164]), which meets the limitation of the system function is a partition manager.

Referring to claims 30, 46, Lewis discloses that if the user has not purchased the content, they may be granted a preview or demo time period to access the content on their data management system ([0205]), which meets the limitation of initiating the grace period comprises initiating a countdown counter.

Referring to claims 31, 47, Lewis discloses that access is blocked after the time period has expired ([0205]), which meets the limitation of preventing the system function from using the on-demand resource after expiration of the grace period.

Referring to claims 32, 48, Lewis discloses that the user can “renew” access to content or purchase content for unlimited usage ([0216] & [0222]), which meets the limitation of terminating the grace period if the system is returned to a compliant state.

Referring to claims 33, 34, 49, 50, Lewis discloses that the data management system can be implemented using a RISC chip (Figure 9 & [0121]), which meets the limitation of recording the compliant state comprises writing to a smart chip, determining the in-compliant state comprises reading a smart chip.

Art Unit: 2132

Referring to claims 35, 51, Lewis discloses that the data management system comprises RAM, CPU, ([0121]) and portioned storage ([0094] & [0164]), which meets the limitation of the on-demand resource is one of a processor, memory and storage.

Referring to claims 36, 39, Lewis discloses a system for on-demand rental and purchase of digital data products wherein users who have purchased digital data content are provided with unlimited usage of said content upon delivery to the data management system of the user ([0087] & [0098] & [0222]), which meets the limitation of on-demand resources configured to be claimed for use by a function, and a capacity manager, which when executed by a processor, is configured to enable the on-demand resources for use by the function, where the computerized apparatus is in a compliant state when the function only claims usage of the enabled on-demand resources and does not claim any disabled on-demand resources. If the user has not purchased the content, they may be granted a preview or demo time period to access the content on their data management system ([0205]), which meets the limitation of initiate a grace period which the function may continue to use the on-demand resources while in the in compliant state for a defined period of time, a persistent storage device to store state information used to determine whether the computerized apparatus is in the compliant state of the in compliant state with respect to the function's claim to usage of the on-demand resources.

Referring to claim 37, Lewis discloses that access is blocked after the time period has expired ([0205]), which meets the limitation of the capacity manager is further configured to implement an enforcement policy restricting the use of the on-demand resources after expiration of the grace period.

Referring to claim 38, Lewis discloses that the user data management system includes storage partitions for storage of the content ([0094] & [0164]), which meets the limitation of the function is a partition manager for managing a plurality of logical partitions.

Referring to claim 40, Lewis discloses that the data management system comprises RAM, CPU, ([0121]) and portioned storage ([0094] & [0164]), which meets the limitation of the on-demand resource is one of a processor, memory and storage.

Referring to claims 41, Lewis discloses that a key is used to unlock protected content when purchased ([0160] & [0191]), which meets the limitation of the capacity manager is configured to enable the on-demand resources by unlocking the on-demand resources and making the on-demand resources available for use upon request.

Referring to claims 42, 43, Lewis discloses utilizing control data that is unique to each device for controlling access to the content ([0215]), which meets the limitation of receive enablement codes configured to enable the on-demand resources, determining whether each enablement code is valid by determining whether the enablement code is unique to the computerized apparatus.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nonaka, U.S. Patent No. 7,073,073

Giaccherini, U.S. Publication No. 2004/0163135

Art Unit: 2132

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E. Lanier whose telephone number is 571-272-3805.

The examiner can normally be reached on M-Th 6:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Benjamin E. Lanier